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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: : Docket No. 6674-0038-1

SYLVIE GAUTHIER et al. : Date: October 29, 2008

Serial No. 10/762,104 Examiner: T. Dicus

Filing Date: January 20, 2004 : Art Unit: 1774

Title: LEATHER LAMINATED DECORATIVE PANEL

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPELLANT'S BRIEF TO THE BOARD OF PATENT APPEALS AND INTERFERENCES  
PURSUANT TO 37 C.F.R. §§1.191 AND 41.37

Dear Sirs:

This brief is in furtherance of the Notice of Appeal, which was filed on September 16, 2008.

I. REAL PARTY IN INTEREST:

The real party of interest is Panolam Industries International, Inc. of Shelton, Connecticut, U.S.A., currently the assignee of record for the present application.

II. RELATED APPEALS AND INTERFERENCES:

U.S. Application Serial No. 10/762,103 (the “ ‘103 Application”) is currently pending and is assigned to the real party of interest in the present application, Panolam Industries International, Inc. Claims 1-9 of the present case are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of the ‘103 Application. An Appeal has been filed in the ‘103 Application.

III. STATUS OF CLAIMS:

A. Total number of Claims in the Application: 20

B. Status of All the Claims:

- 1) Claims cancelled: None
- 2) Claims withdrawn from consideration but not cancelled: Claims 10-20
- 3) Claims pending: Claims 1-9
- 4) Claims allowed: None
- 5) Claims rejected: Claims 1-9
- 6) Claims objected to: None

C. Claims on Appeal: Claims 1-9

IV. STATUS OF AMENDMENTS:

All amendments and responses filed have been entered. A Notice of Appeal was filed with the USPTO on September 16, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER:

Appellant provides below a brief and concise description of each independent and dependent claim under appeal, and identifies specific cites where support for each claim can be found within the specification, including the drawings. Support for each claim is not, however, limited to those specific cites and may also be found in additional areas of the specification and the drawings.

1. A heat and pressure consolidated laminate, comprising in superimposed relationship:  
a decorative layer consisting essentially of a leather material<sup>1</sup>;  
a substrate, having a first surface and a second surface opposite one another<sup>2</sup>;  
an underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin<sup>3</sup>, the underlay layer disposed between the leather decorative layer and the first surface of the substrate<sup>4</sup>;

wherein the decorative layer consisting essentially of a leather material is bonded to the underlay layer along a surface of the decorative layer by thermosetting resin migrated from the underlay layer<sup>5</sup>; and

a backer layer containing one or more cellulosic sheets impregnated with a thermosetting resin<sup>6</sup>, the backer layer disposed adjacent the second surface of the substrate<sup>7</sup>.

2. The laminate of claim 1 wherein said decorative layer is bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm<sup>8</sup>.

3. The laminate of claim 1 wherein said thermosetting resin is a melamine formaldehyde resin<sup>9</sup>.

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<sup>1</sup> Support can be found in paragraph 4, lines 1-7 and 9-13; and in FIGs. 1-3, reference no. 12.

<sup>2</sup> See paragraph 15, lines 1-3 and 5; and in FIGs. 1-3, reference no. 14, 20 and 22.

<sup>3</sup> See paragraph 13, lines 2-9; and in FIGs. 1-3, reference no. 16.

<sup>4</sup> See paragraph 19, lines 1-3; and in FIGs. 1-3, reference no. 10 and 16.

<sup>5</sup> See paragraphs 19-20; paragraph 21, lines 1-9; paragraph 22; and in FIGs. 1-3, reference no. 12 and 16.

<sup>6</sup> See paragraph 16, lines 2-5; and in FIGs. 1-2, reference no. 18.

<sup>7</sup> See paragraph 19, lines 1-2; and in FIGs. 1-2, reference no. 14, 18 and 22.

<sup>8</sup> See paragraph 4, lines 7-9.

4. The laminate of claim 1, wherein said substrate is selected from the group consisting of plywood, particleboard or medium density fiberboard<sup>10</sup>.
5. The laminate of claim 1, further comprising an overlay layer disposed on a side of said decorative layer opposite the underlay layer and substrate<sup>11</sup>.
6. A heat and pressure consolidated laminate, comprising in superimposed relationship:  
a first decorative layer consisting essentially of a leather material<sup>12</sup>;  
a substrate, having a first surface and a second surface opposite one another<sup>13</sup>;  
a first underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin<sup>14</sup>, the first underlay layer disposed between the first decorative layer and the first surface of the substrate<sup>15</sup>;  
wherein the first decorative layer is bonded to the first underlay layer along a surface of the first decorative layer by thermosetting resin migrated from the first underlay layer<sup>16</sup>;  
a second decorative layer consisting essentially of a leather material<sup>17</sup>; and  
a second underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin<sup>18</sup>, said second underlay layer disposed between the second decorative layer and the second surface of the substrate<sup>19</sup>;  
wherein the second decorative layer is bonded to the second underlay layer along a surface of the second decorative layer by thermosetting resin migrated from the second underlay layer<sup>20</sup>.

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<sup>9</sup> See paragraph 13, lines 6-7.

<sup>10</sup> See paragraph 15, lines 3-7.

<sup>11</sup> See paragraph 17, lines 1-3.

<sup>12</sup> See paragraph 4, lines 1-7 and 9-13; paragraph 18, lines 1-3; and in FIG. 3, reference no. 12.

<sup>13</sup> See paragraph 15, lines 1-3 and 5; paragraph 18, lines 1-3; and in FIG. 3, reference no. 14, 20 and 22.

<sup>14</sup> See paragraph 13, lines 3-2; paragraph 18, lines 1-3; and in FIG. 3, reference no. 16.

<sup>15</sup> See paragraph 19, lines 1-3; and in FIG. 3, reference no. 10 and 16.

<sup>16</sup> See paragraphs 19-20; paragraph 21, lines 1-9; paragraph 22; and in FIG. 3, reference no. 12 and 16.

<sup>17</sup> See paragraph 4, lines 1-7 and 9-13; paragraph 18, lines 3-6; and in FIG. 3, reference no. 26.

<sup>18</sup> See paragraph 13, lines 2-9; paragraph 18, lines 3-6; and in FIG. 3, reference no. 28.

<sup>19</sup> See paragraph 19, lines 1-3; and in FIG. 3, reference no. 22, 26 and 28.

<sup>20</sup> See paragraphs 19-20; paragraph 21, lines 1-9; paragraph 22; and in FIG. 3, reference no. 26 and 28.

7. The laminate of claim 6 wherein said first and second decorative layers are bonded leather, said first and second decorative layers each having a sheet thickness ranging from about 0.2 mm to about 4.0 mm<sup>21</sup>.
8. The laminate of claim 6 wherein said thermosetting resin is a melamine formaldehyde resin<sup>22</sup>.
9. The laminate of claim 6, wherein said substrate is selected from the group consisting of plywood, particleboard or medium density fiberboard<sup>23</sup>.

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<sup>21</sup> See paragraph 4, lines 7-9.

<sup>22</sup> See paragraph 13, lines 6-7.

<sup>23</sup> See paragraph 15, lines 3-7.

VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL:

1. Whether claims 1-9 are unpatentable over claims 1-7 of co-pending Application No. 10/762,103 in view of U.S. Patent No. 3,700,537 ("Scher").
2. Whether claims 1-9 are unpatentable over claims 1-5 of U.S. Patent No. 7,179,538 alone or in view of U.S. Patent No. 4,132,821 ("Hiers").
5. Whether claims 1-3 and 5 are unpatentable over U.S. Patent No. 6,440,538 ("Ungar") in view of U.S. Patent No. 1,672,537 ("Novak") or alternatively in view of U.S. Patent No. 5,534,237 ("Nishi").
6. Whether claim 4 is unpatentable over Ungar in view of Novak or alternatively in view of Nishi and further in view of U.S. Patent No. 6,324,809 ("Nelson").
7. Whether claims 1-3 and 5 are unpatentable over U.S. Patent 3,700,537 ("Scher") in view of U.S. Patent 5,811,122 ("Schlup") or alternatively in view of U.S. Patent 5,344,692 ("Schmoock"), Hiers or Nishi.
8. Whether claims 6-8 are unpatentable over Scher in view of Schlup or alternatively in view of Schmoock, Hiers or Nishi.
9. Whether claims 4 and 9 are unpatentable over Scher in view of Schlup or alternatively in view of Schmoock, Hiers or Nishi, and further in view of 6,558,799 ("Takeuchi").

VII. ARGUMENT:

1. Claims 1-9 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-7 of co-pending Application No. 10/762,103 in view of U.S. Patent No. 3,700,537 ("Scher").

The rejection provides that claims 1-9 are not patentably distinct from claims 1-7 of co-pending application 10/762,103. No claims have been allowed in co-pending application serial number 10/762,103. Consequently, appellants respectfully submit that it is premature to determine the necessity of a terminal disclaimer with respect to the cited application. Once a claim is allowed (but for the obviousness double-patenting rejection) in one of the two patent applications, the merit of the present rejection can be evaluated as between the allowed claim and the pending claims in the other application. Appellants therefore respectfully request that the present rejection be held in abeyance until one or more claims are allowed in one of the aforesaid applications.

2. Claims 1-9 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent 7,179,538 alone, or in view of U.S. Patent No. 4,132,821 ("Hiers").

The Official Action contends that "Applicant argues it is premature for a Terminal Disclaimer. For this reason, both ODP rejections stand." Appellants direct the Board to the response below, which was originally submitted in response to the December 13, 2007 Official Action. The response does not argue that the ODP rejection based on the '538 Patent and Hiers is premature. On the contrary, the response indicates that rejection is improper for at least the reason that the backing layer in the '538 patent is patently distinct from the laminates recited in pending claims 1-9.

Claim 1 of the '538 Patent recites a *flexible* heat and pressure consolidated laminate that comprises in superimposed relationship: 1) a *flexible* backing layer containing a polyester impregnated sheet; 2) a decorative layer; and 3) a flexible overlay, all of which layers are consolidated into a laminate.

Claim 1 of the present application, in contrast, recites a heat and pressure consolidated laminate comprising in superimposed relationship: 1) a decorative layer; 2) a substrate having a

first surface and a second surface opposite one another; 3) an underlay layer disposed between the leather decorative layer and the first surface of the substrate; and 4) a backer layer disposed adjacent the second surface of the substrate, all of which elements are consolidated into a laminate. The laminate recited in claim 1 is shown in FIG. 1 of the present application:

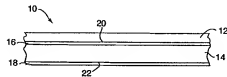


FIG. 1

Comparing the two claim 1s, it can be seen that the claim 1 of the '538 Patent recites a flexible laminate that includes a flexible overlay (for definition and application of "overlay layer", see col. 3, lines 11-20), and a flexible backing layer. Claim 1 of the present application does not recite a flexible laminate, or a laminate having a flexible overlay or a flexible backing layer. Regarding the suggestion that the terms "backing layer" and "substrate" have the same meaning, appellants respectfully disagree. Claim 1 of the present application clearly recites both a backing layer and a substrate disposed in particular arrangement within the laminate, thereby distinguishing one from the other. In addition, the two elements are clearly different based on their definition within the specification.

Claim 6 of the present application, in similar manner also recites a heat and pressure consolidated laminate comprising in superimposed relationship: 1) a first decorative layer; 2) a substrate having a first surface and a second surface opposite one another; 3) a first underlay layer disposed between the first leather decorative layer and the first surface of the substrate; 4) a second decorative layer; and 5) a second underlay layer disposed between the second leather decorative layer and the second surface of the substrate, all of which elements are consolidated into a laminate. The laminate recited in claim 6 is shown in FIG. 3 of the present application:

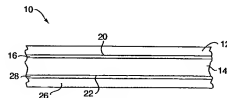


FIG. 3

Furthermore, claims 4 and 9 of the present application provide that the substrate is selected from the group consisting of plywood, particleboard, or medium density fiberboard. According to the '538 Patent, the term "flexible" is defined to mean materials that remain



substantially flaccid, and have the ability to be conformed to two or three dimensional features. A laminate having a substrate selected from the identified group cannot fairly or reasonably be characterized as being flaccid or conformable.

From the above, it can be seen that the laminates recited in claims 1-9 of the present application are patentably distinct from, and not obvious in view of, the flexible laminate recited in claims 1-5 of the '538 Patent. Consequently, appellants respectfully request the obviousness-type double patent rejection be withdrawn.

5. Claims 1-3 and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,440,538 ("Ungar") in view of U.S. Patent No. 1,672,537 ("Novak") or alternatively in view of U.S. Patent No. 5,534,237 ("Nishi").

Ungar in view of Novak:

The rejection provides that Novak teaches a floor covering "built of plies of leather shavings as the surface coat" and that the surface coat is equivalent to a decorative layer consisting essentially of a leather material. To arrive at the claimed laminate, the rejection provides that it would have been obvious to one having ordinary skill in the art to modify the printed paper wear layer of Ungar (from 2002) to use, incorporate, or substitute an improved paper leather material as taught by Novak (from 1922). Finally, the rejection provides that "[b]ecause Ungar was also concerned with abrasion resistance (see the title), it would have been expected that the incorporation of the leather material for the reasons Novak taught successfully envisages the instant invention". Appellants respectfully disagree with the characterization of the references and the rejection based thereon.

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art." 35 U.S.C. §103(a); *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286, 1288 (Fed. Cir. 2006) (citing *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006) and *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 13-14 (1966)). "Most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn*, 441 F.3d 977

(Fed.Cir 2006), citing *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998) “Such a combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (U.S. 2007) (quoting *Graham*, 383 U.S. at 15). The analysis should be made explicit. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d at 988

Claim 1 recites a heat and pressure consolidated laminate that comprises: 1) a decorative layer consisting essentially of a leather material; 2) a substrate, having a first surface and a second surface opposite one another; 3) an underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin; and 4) a backer layer containing one or more cellulosic sheets impregnated with a thermosetting resin. The decorative layer consists essentially of a leather material that is bonded to the underlay layer along a surface of the decorative layer by thermosetting resin migrated from the underlay layer.

The Official Action states that “Applicant argues the Novak patent in this rejection, pointing to the 5.5% calculated leather shavings to base his argument that this is not a decorative layer consisting essentially of a leather material. However, this is not convincing because consisting essentially language is construed as open language and Applicant has not proven a deleterious effect.” (pg. 9, second paragraph). Appellants respectfully disagree.

In *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354 (Fed. Cir. 1998), the Federal Circuit provided that “consisting essentially of” is a permissible transition phrase that can be used to signal that the invention necessarily includes the listed element and is open to unlisted elements that do not *materially affect* the basic and novel properties of the invention. *Id.* The rejection indicates that “[a]bsent a clear indication in the specification or claims of what the basic and novel characteristics actually are (e.g., a percentage of leather), ‘consisting essentially of’ will be construed as equivalent to ‘comprising’.” See, e.g., *PPG*, 156 F.3d at 1355.” This reference to the *PPG* case is misleading, however, since the described way of construing the phrase is nowhere found in the *PPG* case.

In *PPG*, the Federal Circuit opined that under well settled principles, the drafter of the patent was entitled to provide its own definition of the terms used in the patent claim, and that

the scope of the term “consisting essentially of” can be established by the specification. Such is the case here.

Claim 1 recites a laminate having “a decorative layer consisting essentially of a leather material”. The specification defines the recited decorative layer by stating that “[t]he ‘leather’ referred to herein is an animal hide and is not limited to any particular type of animal. Preferably, the leather material is bonded leather.” ([0004]). The specification defines that the leather is a solid layer of natural animal hide in a sheet thickness preferably in the range between 0.2mm and 4.0mm. The specification provides further that leather is perceived as a quality material. ([0002]) That perception is based on the look, feel, and smell qualities of leather. The qualities of leather necessarily depend on the amount of leather present and the form of the leather.

The floor covering taught in Novak includes:

Constituent	Parts	% of total
Leather shavings	60	5.5%
Cotton or jute	40	4%
Wood flour or cork	125	11%
Coloring pigments	50	4.5%
Dry varnish, linseed oil, copal	500	46%
Clay	200	18%
Sodium Silicate	50	4.5%
Aluminum	50	4.5%

Novak teaches that the wear and waterproof properties of the floor covering are substantially affected by the higher binder proportion. (col. 1, lines 40-46). Consequently, it is clear from the disclosure of Novak that the “unlisted elements” disclosed by Novak (e.g., cotton or jute, wood flour or cork, coloring pigments, varnish, linseed oil, copal, clay, sodium silicate, and aluminum) do have a material effect of the basic and novel properties of the flooring taught by Novak, and therefore would also materially affect the ability of the flooring of Novak to act as a decorative layer consisting essentially of a leather material as is recited in the present claims.

Ungar discloses an abrasion resistant laminate that includes a wear-resistant top layer assembly 5, an adhesive layer 9, and a base layer 10. The wear-resistant layer 5 includes an overlay layer 6, a decorative layer 7, and a core layer 8. The base layer 10 is adhered to the wear-resistant layer 5 by the adhesive layer 9. (col. 4, lines 10-21) The decorative layer 7 is a printed or colored paper which may or may not be treated with a resin. (col. 6, lines 64-65)

Novak discloses a floor covering that includes a surface ply and a base ply. The base is a fibrous material. It can be seen, therefore, that Novak does not teach a floor covering “built of *plys* of leather shavings as the surface coat” (emphasis added) as is suggested in the rejection. In fact, Novak teaches a floor covering with a single surface ply that comprises a very small amount of leather shavings (e.g., 5.5%). Furthermore, the surface ply taught by Novak (is not equivalent to a decorative layer *consisting essentially of a leather material* as is recited in the present claims. A surface ply as taught by Novak (e.g., comprising 5.5 % of leather shavings, wood flour, clay, etc.) is also not equivalent to the recited decorative layer because, *inter alia*, it will not have the aesthetic look, feel, and smell that is attendant to a decorative layer *consisting essentially of a leather material*. Consequently, the combined teachings of the cited references do not arrive at the claimed laminate.

With respect to the suggestion in the rejection that it would be obvious to combine the leather material of Novak with the laminate of Ungar because Ungar and Novak were both concerned with abrasion resistance, appellants respectfully refer to the specification of Novak which provides:

The floor covering which is the subject of this invention, has a superior wearing surface to the linoleum and floor coverings now commonly used in that it has higher resistance to abrasion due to the higher binder proportion... (col. 1, lines 40-46)

The above passage is clear that the higher abrasion resistance of the floor covering of Novak is due to the higher binder proportion. There is no disclosure within Novak that the leather shavings, and in particular the very small percentage of the leather shavings, play any part in the abrasion resistant characteristics of the floor covering of Novak. Consequently, there is no basis for the suggestion that leather shavings of Novak could be combined with the laminate of Ungar for purposes of providing an abrasion resistant surface.

It should also be noted that in response to Appellants’ traverse of the alleged motivation to combine based on “abrasion resistance”, the Examiner changed her position. The rejection now contradicts the earlier portion, indicating that “Novak need not play any part in abrasion resistance as Applicant alleges.” Appellants respectfully submit that it was the Examiner that suggested that abrasion resistance was the motivation to combine the reference. The new

unsubstantiated motivation is to use the leather material of Novak in the laminate of Ungar to make it “tougher and thus stronger”. The Examiner provides no basis for the new claim that the combined references would be “tougher and thus stronger”, and appellants find none within the references either. As stated above, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d at 988. Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight. *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)

In addition, the Examiner admits that the proposed combination of elements selected from the cited references do not arrive at the claimed laminate (i.e., “the references do not teach a migrated resin from an underlayer”). To arrive at the claimed laminate, the Examiner provides that the migration of resin into leather is “expected”. In making an obviousness analysis, the Examiner must avoid falling prey to “the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000), quoting W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Appellants respectfully submit that bond between the underlay layer and the leather decorative layer, which bond is created by the migration of the thermosetting resin from the underlay layer into a portion of the leather decorative layer, creates an advantageous bond without diminishing the aesthetic qualities of the leather decorative layer. The contrast between this type of bond and the “500 parts of varnish” disclosed in Novak illustrates well the fact that the present invention is not “predictable” in view of the cited references. Consequently, appellants respectfully submit that the method of bonding is not “expected” and that the proposed combination of references is a product of impermissible hindsight.

For at least the reasons provided above, appellants respectfully request that the rejection be reversed.

#### Ungar in view of Nishi:

The Official Action further contends that “it would have been obvious to one having ordinary skill in the art to have modified Ungar also to include decorative leather material for Nishi’s reasons such as good touch, and grip material having tactile quality.” (Official Action,

pages 6-7, paragraph 6). Appellants respectfully disagree with the characterization of the references and the rejection based thereon.

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP §2142.02, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The claimed laminate, therefore, must be considered as a whole.

As indicated above, Ungar discloses an abrasion resistant laminate that includes a wear-resistant top layer assembly 5, an adhesive layer 9, and a base layer 10. The wear-resistant layer 5 includes an overlay layer 6, a decorative layer 7, and a core layer 8. The base layer 10 is adhered to the wear-resistant layer 5 by the adhesive layer 9. (col. 4, lines 10-21) The decorative layer 7 is a printed or colored paper which may or may not be treated with a resin. (col. 6, lines 64-65)

Nishi discloses a powdered leather that can be mixed with a resin and used in the manufacture of certain products such as coating/paint, synthetic or artificial leather, film, sheet, fibers, and moldings. (col. 1, lines 14-17) Specific examples of how the powdered leather may be incorporated into products include: I.) Compositions containing the powdered leather; II.) Leather like moldings; III.) Film or sheet containing powdered leather; IV.) Laminate; and V.) Leather-like grip cover. (col. 6, lines 40-42)

I.) Compositions containing the powdered leather: Nishi discloses that products may be made using elements that include a composition having 1-90% of powdered leather and 99-10% of resin or rubber (col. 6, lines 44-47), with the final product having a far lower percentage of powdered leather; e.g., Nishi discloses that powdered leather (as a constituent raw material) may be mixed with a synthetic leather blank (made from resin) to form a film having 5-50% powdered leather (i.e., a film that does not consist “essentially of a leather material”) (col. 7, lines 35-41). In fact, none of the actual products made with elements including the composition, according to Nishi, have a layer more than 60% powdered leather by weight. (see col. 7, line 35 – col. 8, line 10). Nishi cautions against a layer having more than 90% powdered leather in the production of a product because the composition becomes fragile. (col. 7, lines 24-30) In short, Nishi: 1) does not teach a product having a decorative layer consisting essentially of leather as an element within a laminate; 2) actually teaches away from a laminate having a decorative layer

that “consists essentially of a leather material” by indicating that a composition having 90% or more of powdered leather is fragile; and 3) discloses that the 99 to 10% resin or rubber materially affects the powdered leather by acting as a binder of the leather powder.

II.) Leather like moldings: Nishi discloses that leather-like moldings can be made using a mixture of 1-90% of powdered leather and 99-10% resin or rubber. (col. 8, lines 12-16) The materials are processed into pellets or powder and are subsequently plasticized and attached or poured into a molding template using molding techniques such as compression molding, rotation molding, and powder slush molding. (col. 8, line 64 to col. 9, line 5)

III.) Film or sheet containing powdered leather: Nishi discloses that a film or sheet can include a composition of 1-90% of powdered leather and 99-10% of resin or rubber, and additives such as fibers, etc. (col. 9, lines 9-23) In the case of a film, Nishi discloses that the content of the powdered leather in the resin is preferably 5-10% by weight. In the case of a sheet, Nishi discloses that the content of the powdered leather in the resin is preferably 10-60% by weight. (col. 9, lines 56-59) Neither the film nor the sheet consists “essentially of a leather material”. Here again, Nishi cautions that a film or sheet that includes a composition of more than 90% powdered leather will become fragile. (col. 9, lines 52-54) In other words, Nishi clearly teaches away from a laminate having a decorative layer that “consists essentially of a leather material”.

IV.) Laminate: The laminate is the film or sheet disclosed above that is applied to a substrate as a coating, or is adhered to the substrate by an adhesive. (col. 10, lines 1-4; lines 15-37). As shown above, the film or sheet is no more than 60% leather powder.

V.) Leather-like grip cover: The leather-like grip cover comprises a skin layer that consists of 5-60% by weight of powdered leather and 95-40% of synthetic resin. (i.e., the cover does not consist “essentially of a leather material”).

In short, a fair, detailed reading of Nishi reveals that: 1) Nishi discloses a powdered leather that can be included when mixed with resin –resin that is a material part of the powdered leather - into products such as coatings, synthetic leather, etc.; 2) the nature of the products disclosed by Nishi (e.g., a synthetic leather having a film of powdered leather about 30  $\mu$ m thick, a “leather-like” grip cover, etc.) are fundamentally different from the decorative layer disclosed by Ungar (and the decorative layer recited in the present application); and 3) that both Ungar and Nishi teach away from including a decorative layer consisting essentially of a powdered leather

into an abrasion resistant laminate as taught by Ungar. According to Ungar, the object of the invention is to provide an abrasion resistant laminate that has a wear-resistant surface (col. 1, lines 26-29), that is waterproof or water repellant, and that is less expensive to produce. (col. 2, lines 28-32) The powdered leather of Nishi do not satisfy any of these objects, and actually teach away from the proposed combination; e.g., leather has poor wear resistant properties, is not waterproof, and is considerably more expensive than a conventional paper decorative sheet.

For at least these reasons, appellants respectfully submit that the laminate recited in claims 1-3, and 5 is neither obvious nor predictable in view of Ungar and Nishi, and that Ungar and Nishi actually teach away from the proposed combination. Consequently, appellants respectfully request this rejection be reversed.

6. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ungar in view of Novak or alternatively in view of Nishi and further in view of U.S. Patent No. 6,324,809 ("Nelson"). According to the rejection, the combinations of Ungar, Novak and Nishi do not teach a substrate of plywood or particle board or MDF. The rejection relies upon Nelson for the teaching of a substrate of plywood or particle board of MDF.

Appellants respectfully direct the Board to the remarks above regarding the proposed combinations of Ungar and Novak, and Ungar and Nishi. For at least those reasons, appellants respectfully submit that claim 4 is not obvious in view of the cited references and request the rejection be withdrawn.

7. Claims 1-3 and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 3,700,537 ("Scher") in view of U.S. Patent 5,811,122 ("Schlup") or alternatively in view of U.S. Patent 5,344,692 ("Schmooch") or Hiers.

Scher in view of Schlup:

Scher discloses a laminate having a print sheet 16 to provide a decorative background, and an embedment sheet 18 having an opening passing therethrough. (Col. 5, lines 1-54) Scher indicates that it is desirable to "produce high pressure laminates with deeply embossed surfaces that duplicate natural products such as slate, leather, and wood" (Col. 2, lines 47-56), and that it is an object of the invention to produce such laminates in a simplified and inexpensive manner.



Hence, Scher teaches that it is desirable to produce an inexpensive, high pressure laminate that duplicates, *but does not use*, a natural product such as slate, leather or wood. There is no disclosure within Scher that a high pressure laminate could be made less expensively by substituting a natural material such as leather in place of a cellulosic print sheet made to look like leather. On the contrary, Scher goes to great lengths to disclose embossing techniques operable to create a laminate that looks like but is less expensive than a laminate with a leather decorative layer.

Schlup, conversely, discloses a leather composite material formed by in situ polymerization of polymer precursors fully impregnated into the leather. The stated purpose of the composite material formed by in situ polymerization is to provide a leather material with improved bulk material properties (e.g., toughness, strength, modulus). (Col. 10, lines 28-33) The leather is first fully impregnated with a solvent. According to Schlup, the term "fully impregnated" means "that the interstitial void spaces between the collagen fibers existing throughout the entire thickness of the collagen fiber network of the hide/leather have been substantially filled with the polymer system precursor solution during impregnation." (Col. 9, line 62-66) According to Schlup, a precursor solution containing polymer precursors is subsequently applied to the leather in a fashion that permits full impregnation of the precursor solution throughout the leather. (Col. 3, line 40 to Col. 4, line 53) The fully impregnated leather is subsequently processed to cure the polymer system.

There is no disclosure within Schlup that the disclosed leather/polymer composite material is or can be used within a high pressure laminate.

Claim 1 recites a heat and pressure consolidated laminate that includes, *inter alia*, a decorative layer consisting essentially of a leather material and an underlay layer that contains one or more cellulosic sheets impregnated with a thermosetting resin. The leather decorative layer is bonded to the underlay layer along a surface of the leather decorative layer by thermosetting resin migrated from the underlay layer. The leather decorative layer is not fully impregnated with a polymer system as is disclosed within Schlup, and therefore intentionally does not have the bulk properties that are associated with a fully impregnated and cured leather layer. Indeed, the desirability of having the leather decorative layer is the feel, smell and touch of the leather decorative laminate. Neither the embossed paper of Scher nor the fully impregnated leather layer of Schlup provides such desirable qualities.

As stated above, Scher teaches that it is desirable to produce an inexpensive, high pressure laminate that duplicates a natural product such as slate, leather or wood and discloses embossing techniques to create such a laminate.

Schlup, on the other hand, discloses a leather/polymer composite that is fully impregnated and fully cured, i.e., one incapable of being consolidated into a high pressure laminate from a buildup of sheets impregnated with B-stage resin as is taught by Scher (col. 2, lines 1-3). Hence, the disclosures of Scher and Schlup teach away from the proposed combination.

In addition, Schlup discloses a leather composite material formed by in situ polymerization of polymer precursors fully impregnated into the leather to provide the leather material with improved bulk material properties (e.g., toughness, strength, modulus). Schlup discloses that the full impregnation and subsequent polymerization of the leather significantly changes the leather, and gives the example that leather treated thereafter has markedly reduced ability to absorb and permeate water vapor. As indicated above, the advantage of including a leather decorative sheet within a laminate as is recited in claims 1-9, is that the leather decorative sheet is bonded but still retains the look, feel, and smell of natural leather. Hence, Schlup teaches away from the proposed combination by disclosing a leather product unsuitable for the claimed laminate.

The rejection provides that it would have been obvious to one having ordinary skill in the art to modify the composite of Scher to use the leather material of Schlup for the purpose of improving several properties surrounding those affected by heat and pressure namely, toughness, machinability, compressibility, and sealing where such an improvement in laminated composites is needed in the hide and leather industries as taught by Schlup. Appellants respectfully disagree—"toughness, machinability, compressibility, and sealing" are not desirable qualities in a decorative layer, and these properties do not provide a rationale for combining the teachings of Scher and Schlup.

The rejection places great emphasis on the disclosure within Scher that "[w]ith respect to the woven embodiment 18, this may be of almost any construction", apparently interpreting that line to mean that the woven embodiment may be any material whatsoever. That interpretation is neither fair nor reasonable, and is contradicted by the specification of Scher. As provided above, Scher discloses a laminate having a print sheet 16 that provides a decorative background and a

woven embedment sheet 18. (col. 5, lines 5-10) A laminate having a leather decorative layer would not need a print sheet. Hence, the proposed modification would render a portion of Scher's laminate useless. All of these aspects teach away from using a decorative layer consisting essentially of a leather material.

For at least the reasons provided above, appellants respectfully request that the rejection be reversed and claims 1-3 and 5 be passed to allowance.

Scher in view of Schmook:

The rejection describes Schmook as teaching "a leather-containing composite material used in structural composite materials in applications of heat and/or pressure" and is "considered to be equivalent to Applicant's claimed leather or bonded lather material". The rejection provides that it would have been obvious to one of ordinary skill in the art to have modified the composite material of Scher to use the leather composite material of Schmook. Appellants respectfully traverse the rejection and direct the Examiner to the comments above regarding Scher.

Schmook discloses a leather-containing laminate that includes a coating applied to a leather substrate. The coating includes an outer layer and an inner layer. The inner layer is disposed between the outer layer and the leather substrate. The inner layer adheres to the uneven side of the leather substrate and serves as a means for filling, or at least substantially filling, the surface irregularities in the one side of the leather substrate. Schmook discloses that the inner layer may be a thermoplastic or a lacquer. There is no disclosure of the leather substrate being bonded to an underlay layer impregnated with a thermosetting resin, or suggestion that it may be consolidated in a high pressure laminate.

Regarding the proposed combination of Scher and Schmook, Scher teaches that it is desirable to produce an inexpensive, high pressure laminate that duplicates a natural product such as slate, leather or wood. To arrive at such a product, Scher discloses embossing techniques operable to create a laminate that looks like but is less expensive than a laminate with a leather decorative layer. Hence, Scher provides inexpensive alternatives to a laminate that includes a leather decorative layer and therefore teaches away from including a leather decorative sheet. The fact that Schmook discloses a leather coating that may enable less expensive leather to be used does not avoid the fact that Scher teaches away from using a leather decorative layer.

Scher in view of Hiers:

The rejection describes Hiers as teaching the use of leather containing animal hides (see 1:6-9) in a non-woven composite under a hot press. The rejection provides that it would have been obvious to one of ordinary skill in the art to have modified the composite material of Scher to use “leather comprising animal hides as taught by Hiers.” (pg 12, fourth paragraph). Appellants respectfully traverse the rejection and direct the Board to the comments above regarding Scher.

In addition, appellants direct the Board to: 1) col. 1, lines 1-23 of Hiers which describe the disadvantages of using natural leather; 2) col. 2, lines 45-56 which disclose that it is an object of the invention to provide an *artificial* leather; and 3) col. 4, lines 16-26 which describe a major feature of the invention is a process for producing a leather substitute material. The leather substitute material disclosed by Hiers involves a skin coating applied to a fibrous substrate (see col. 6). In short, the material disclosed by Hiers does not consist essentially of (or any portion of) a leather material.

Consequently, the combination of Scher and Hiers does not arrive at the claimed laminate, nor is the claimed laminate predictable in view thereof. This is particularly true in view of the teaching away by the references described above (e.g., Scher’s teaching to use paper in place of leather, and Hiers’ teaching of using an artificial leather).

For at least the reasons provided above, appellants respectfully request that the rejection be withdrawn and the present application be passed to allowance.

Scher in view of Nishi:

The Official Action contends that “it would have been obvious to one having ordinary skill in the art to have modified Scher also to include decorative leather material for Nishi’s reasons such as good touch and grip material having tactile quality.” (pg 13, second paragraph). Appellants respectfully disagree with the characterization of the references and the rejection based thereon, and direct the Board to the comments above regarding Scher and Nishi.

As stated above, a fair, detailed reading of Nishi reveals that: 1) Nishi discloses a powdered leather that can be included when mixed with resin into products such as coatings, synthetic leather, etc.; 2) the nature of the products disclosed by Nishi (e.g., a synthetic leather

having a film of powdered leather about 30 µm thick, a “leather-like” grip cover, etc.) are fundamentally different from the decorative layer disclosed by Scher (and the decorative layer recited in the present application); and 3) both Scher and Nishi teach away from including a decorative layer consisting essentially of a powdered leather into a laminate as taught by Scher. According to Scher, the object of the invention is to provide a laminate having a deeply embossed surface, and one that is inexpensive to produce. (col. 3, lines 63-65) The powdered leather of Nishi does not satisfy any of these objects, and actually teaches away from the proposed combination; e.g., leather is considerably more expensive than a conventional paper decorative sheet.

For at least these reasons, appellants respectfully submit that the laminate recited in claims 1-3, and 5 is neither obvious nor predictable in view of Scher in view of Schlup, Scher in view of Schmook, Schjer in view of Hiers, or Scher in view of Nishi. Consequently, appellants respectfully request this rejection be reversed.

8. Claims 6-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Scher in view of Schlup, or alternatively in view of Schmook, Hiers or Nishi.

Appellants respectfully direct the Board to the remarks above regarding the proposed combination of Scher and Schlup, or Schmook, or Hiers, or Nishi. For at least those reasons, appellants respectfully submit that claims 6-8 are not obvious in view of the cited references and request the rejection be withdrawn.

9. Claims 4 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Scher in view of Schlup or alternatively in view of Schmook or Hiers or Nishi, and further in view of 6,558,799 (“Takeuchi”).

Appellants respectfully direct the Board to the remarks above regarding Scher, Schlup, Schmook, and Nishi and the proposed combinations thereof. For at least the reasons identified, appellants respectfully submit that the laminate of claims 4 and 9 is not obvious in view thereof.

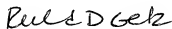
The rejection indicates that Takeuchi is relied upon as disclosing a substrate consisting of plywood, fiberboard, or particleboard. Appellants respectfully submit that the addition of Takeuchi does not overcome the shortcomings identified above with respect to the combined teachings of Scher, Schlup, Schmook and Nishi.

For at least the reasons provided above, appellants respectfully request that the rejection be withdrawn and the present application be passed to allowance.

VIII. CONCLUSION:

In view of the fact that all of the rejections and objections have been traversed, appellants respectfully request the aforesaid rejections and objections be withdrawn and the present case be passed onto allowance. Please charge our Deposit Account No. 50-3381 for any additional fee that may be due in the filing of this Appeal Brief.

Respectfully submitted,



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IX. CLAIMS APPENDIX:

1. (Previously Presented) A heat and pressure consolidated laminate, comprising in superimposed relationship:

a decorative layer consisting essentially of a leather material;

a substrate, having a first surface and a second surface opposite one another;

an underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin, the underlay layer disposed between the leather decorative layer and the first surface of the substrate;

wherein the decorative layer consisting essentially of a leather material is bonded to the underlay layer along a surface of the decorative layer by thermosetting resin migrated from the underlay layer; and

a backer layer containing one or more cellulosic sheets impregnated with a thermosetting resin, the backer layer disposed adjacent the second surface of the substrate.

2. (Original) The laminate of claim 1 wherein said decorative layer is bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm.

3. (Original) The laminate of claim 1 wherein said thermosetting resin is a melamine formaldehyde resin.

4. (Original) The laminate of claim 1, wherein said substrate is selected from the group consisting of plywood, particleboard or medium density fiberboard.

5. (Original) The laminate of claim 1, further comprising an overlay layer disposed on a side of said decorative layer opposite the underlay layer and substrate.

6. (Previously Presented) A heat and pressure consolidated laminate, comprising in superimposed relationship:

- a first decorative layer consisting essentially of a leather material;
- a substrate, having a first surface and a second surface opposite one another;
- a first underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin, the first underlay layer disposed between the first decorative layer and the first surface of the substrate;

- wherein the first decorative layer is bonded to the first underlay layer along a surface of the first decorative layer by thermosetting resin migrated from the first underlay layer;

- a second decorative layer consisting essentially of a leather material; and
- a second underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin, said second underlay layer disposed between the second decorative layer and the second surface of the substrate;

- wherein the second decorative layer is bonded to the second underlay layer along a surface of the second decorative layer by thermosetting resin migrated from the second underlay layer.

7. (Original) The laminate of claim 6 wherein said first and second decorative layers are bonded leather, said first and second decorative layers each having a sheet thickness ranging from about 0.2 mm to about 4.0 mm.

8. (Original) The laminate of claim 6 wherein said thermosetting resin is a melamine formaldehyde resin.

9. (Original) The laminate of claim 6, wherein said substrate is selected from the group consisting of plywood, particleboard or medium density fiberboard.



X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.